



UNITED STATES PATENT AND TRADEMARK OFFICE

*CMW*

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,014	08/24/2001	Janet Marie Wasowicz	2100632-991122	3590

7590 06/24/2003

Timothy W. Lohse  
Gray Cary Ware & Freidenrich  
1755 Embarcadero Road  
Palo Alto, CA 94303

EXAMINER

HARRIS, CHANDA L

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 06/24/2003

*12*

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/939,014	WASOWICZ ET AL.
Examiner	Art Unit	
Chanda L. Harris	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 07 April 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1,3-19,21-37,39-55 and 57-133 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) See Continuation Sheet is/are rejected.

7)  Claim(s) See Continuation Sheet is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11  
4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims rejected are 1,5,7-10,12,14,18,19,23,25-28,30, 32, 36,37, 41,43-46,48,50, 54,55,57,60,62-65,67, 69, 73-85,90-95,99,100-105,109,110-115,119,120-125,129,130-132 and 133.

Continuation of Disposition of Claims: Claims objected to are 3,4,6,11,13,15-17,21,22,24,29,31,33-35,39,40,42,47,49,51-53,58,59,61,66,68,70-72,86-89,96-98,106-108,116-118 and 126-128.

## **DETAILED ACTION**

### ***Status of Claims***

In response to the Amendment filed on 4/7/03, Claims 1, 3-19, 21-37, 39-55, and 57-133 are pending.

### ***Information Disclosure Statement***

The electronic documents listed on the Information Disclosure Statement filed on 4/7/03 are not considered because they are not in the proper format. See MPEP 707.05(e) for the proper format to use in citing references retrieved from electronic media sources (e.g. the Internet).

### ***Specification***

The continuity data on page one of the specification needs to be updated. Appropriate correction is required.

### ***Claim Objections***

Claims 86-89 are objected to because of the following informalities: Claims 86-89 are missing. There are no claims numbered 86-89. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 74-77 recite the limitation "the recommended training module" in line 2.

There is insufficient antecedent basis for this limitation in the claim.

2. Claims 99, 109, 119, and 129 recite the limitation "the user's phonological skills" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 5, 7-10, 12, 18-19, 23, 25-28, 30, 36-37, 41, 43-46, 48, 54-55, 57, 60, 62-65, 67, 73-85, 90-95, 99-100, 102-105, 109-110, 112-115, 119-120, 122-125, 129-130, and 132-133 are rejected under 35 U.S.C. 102(b) as being anticipated by Corder (US 5,692,906).**

1. [Claims 1, 19, 37, 55, 57, 74-81, 93-95, 100, 104-105, 110, 114-115, 120, 124-125, 130]: Regarding Claims 1, 19, 37, 55, 57, 74-81, 93-95, 100, 104-105, 110, 114-115, 120, 124-125, and 130, Corder discloses a server computer comprising one or more tests for determining deficiencies in one or more reading and pre-reading skills (e.g. testing the student's ability to reproduce, recognize, pronounce, spell, and

translate, communication skills necessary for use of the English language, rules of grammar) and on or more client computers that may establish a communication session with the server computer, each client computer comprising means for displaying at least one of a graphical image and an audio associated with each test located on the server, means for receiving a user response to one of the graphical images and audio presented by each test means for communicating the responses for each test back to the server computer so that a skill level for each test and each reading or pre-reading skill being test by the test is determined. See Col.3: 42-53, Col.6: 14-17, 32, Col.11: 59- Col.12: 25, Col.7: 51-52, and Col.14: 19-64. Corder discloses a scorer for determining a score for each test. See Col.12: 18-25.

2. [Claims 5, 23, 41,60]: Regarding Claims 5, 23, 41, and 60, Corder discloses wherein the user input device of the one or more client computers comprise a speech recognition device for receiving a verbal response from the user to one or more tests. See Col.3: 67-Col.4: 4, Col.10: 36-44, and FIG. 2A, component 242. Digitally recording of voice requires the recognition of speech and the digitized interpretation thereof.

3. [Claims 7, 25, 43, 62]: Regarding Claims 7,25, 43, and 62, Corder discloses wherein the tests further comprise a rhyme recognition test further comprising means for providing at least two stimuli to the user and means for receiving user input in response to the at least two stimuli to determine the user's ability to recognize rhyming words. See Col.13: 64. Regardless of whether or not Corder uses rhyming recognition to test the user's hearing channel, Corder discloses rhyme a recognition test (i.e. recognizing rhyming words). A recitation of the intended use of the claimed invention

(i.e. to determine the user's ability to recognize rhyming words) must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

4. [Claims 8, 26, 44,63]: Regarding Claims 8,26, 44, and 63, Corder discloses wherein the tests further comprise a test for recognizing the beginning sound of a stimulus, the test comprising means for generating at least one stimulus having at least an initial phoneme (i.e. beginning sound) and means for receiving a response to the stimulus that indicates an ability of the test taker to recognize the initial phoneme of the stimulus. See Col.14: 1.

5. [Claims 9, 27,45,64]: Regarding Claims 9,27, 45, and 64, Corder discloses wherein the tests further comprise a test for recognizing the ending sound of a stimulus, the test comprising means for generating at least one stimulus having at least an ending phoneme (i.e. ending sound) and means for receiving a response to the stimulus that indicates the ability of the test taker to recognize the ending phoneme of the stimulus. See Col.14: 2.

6. [Claims 10, 28,46,65]: Regarding Claims 10,28, 46, and 65, Corder discloses wherein the tests further comprise a rhyme generation test comprising means for generating a stimulus and means for receiving a response from the user identifying a sound that rhymes with the stimulus (i.e. using rhyming words to complete sentences). See Col.14: 4.

7. [Claims 12, 30,48,67]: Regarding Claims 12,30, 48, and 67, Corder discloses wherein the tests further comprise a sound segmentation test (i.e. identifying syllables in words) comprising means for generating at least one stimulus and means for receiving a response to the stimulus comprising means for segmenting the stimulus into smaller units in order to test the ability to segment the stimulus into smaller units. See Col.14:

5. A recitation of the intended use of the claimed invention (i.e. in order to test the ability to segment the stimulus into smaller segments) must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

8. [Claims 18, 36,54,73, 103, 113,123,133]: Regarding Claims 18,36, 54, 73,103, 113, 123, and 133, Corder discloses wherein the tests further comprise a fluency test comprising means for generating a plurality of visual stimuli and means for receiving a user's response to the visual stimuli within a predetermined time interval to determine the user's ability to read and understand the visual stimuli. See Col.14: 19-31.

9. [Claims 82-92]: Regarding Claims 82-92, Corder discloses wherein the pre-reading and reading skills further comprise spelling skills. See Col.5: 4-11.

10. [Claims 99, 102,109, 112,119,122,129,132]: Regarding Claims 99,102, 109, 112, 119, 122, 129, and 132, Corder discloses wherein the computer managed instruction further comprises tracking, over time, the proficiency of the user's phonological skills (i.e. ability to reproduce, recognize, pronounce, spell, and translate, communication skills necessary for use of the English language, rules of grammar) and establishing the

baseline abilities of the user (i.e. trend analysis). See Col.3: 42-53, Col.6: 12-16, 33, and Col.12: 18-25.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 14, 32, 50, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corder in view of Jenkins et al. (US 6,331,115).**

[Claims 14,32,50,69]: Regarding Claims 14,32, 50, and 69, Corder does not disclose expressly a verbal recall test comprising means for generating at least one sound stimulus and means, in response to the at least one stimulus, for receiving a user response indicating the recalling of at least one sound stimulus (i.e. via selecting at least one corresponding tile that plays the same auditory phoneme). However, Jenkins teaches such in Col.3: 31-41. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the aforementioned limitation into the method and system of Corder, in light of the teaching of Jenkins, in order to train short-term memory.

**Claims 101, 111, 121, and 131 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corder.**

[Claims 101,111,121,131]: Regarding Claims 101,111,121, and 131, Corder does not disclose expressly generating a comparison of the scores of different users of the system. However, generating a comparison of scores of different users of a system is old and well known in the art. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate generating a comparison of scores of different users of the system in order to derive a trend analysis of the performance of the students.

#### ***Allowable Subject Matter***

Claims 3-4, 6, 11, 13, 15-17, 21-22, 24, 29, 31, 33-35, 39-40, 42, 47, 49, 51-53, 58-59, 61, 66, 68, 70-72, 96-98, 106-108, 116-118, and 126-128 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Citation of Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Walker (US 5,421,731)  
-method for teaching reading and spelling

***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection and or further explanation. See rejection above. Therefore, this action is made NON-FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanda L. Harris whose telephone number is 703-308-8358. The examiner can normally be reached on M-F 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Ch.  
ch.  
June 18, 2003



MARK SAGER  
PRIMARY EXAMINER